

REMARKS

This Amendment is in response to the Office Action mailed October 3, 2003. In the Office Action the Examiner objected to the Specification, allowed claims 1-27, rejected claims 28-34, 41-51 and 53-64, and objected to claims 35-39 and claim 52. With this Amendment the Specification is amended, claims 28, 40, 47, 49, 50, 54 and 57 are amended, claims 65-69 are presented and the remaining claims are unchanged. Amendments to this application are made in accordance with 37 CFR §1.173 rules for Reissue Specification, Drawings and Amendments. Attached to this amendment is a listing of the status of all the claims and an indication of the support for each amendment. Reconsideration and allowance of claims 1-64 are respectfully requested in view of the following remarks.

While reviewing the claims the Applicant noted a typographical error in claim 47. The word "method" in claim 47 was mistyped as "methos". The amendment to claim 47 corrects this error. Entry is respectfully requested.

On page 2 of the Office Action the Examiner objected to the Specification due to the following informality. The Examiner indicated that in column 6, line 1 that reference number 140 should be corrected to 14. With this Amendment the Specification is corrected as requested by the Examiner. Reconsideration and withdrawal of the objection is respectfully requested.

On page 2 of the Office Action, the Examiner rejected claims 28, 31-34, 40, 46-49, 54, 56, 59, 64 under 35 U.S.C. §102(e) as being anticipated by Rubinson (U.S. Patent No. 5,347,221). The Examiner indicated that the features of the claims of the present invention are directly readable on the Rubinson reference. As the claims have been amended in the present invention the Applicant must respectfully disagree with the Examiner.

The Rubinson reference discloses a catheter or probe for insertion into the human body to map or image an object inside a body. The probe of Rubinson generates a radio frequency (RF)

radiation from within the probe. See the Abstract, column 3, lines 53-57; column 8, lines 2-30 and column 9, lines 19-22. A radio frequency or microwave frequency pulse may then be transmitted down the central conductor of the probe to generate a magnetic field in the vicinity of the short circuited end of the probe. The short circuiting of the wires, whether they are coaxial or not, within the probe or catheter generates addition bulk for the probe that restricts the movement and reach of the probe within the body and in particular very narrow vessels. Further, the disclosure of the Rubinson reference refers to the invention as the "large truncated imaging probe". See column 5, lines 21-22. This is in contrast to the teaching of the present invention.

The present invention requires in claims 28, 40, 49, 50, 54 and 57, as amended, that the magnetic field gradient and the electromagnetic radiation be generated external from the patient's body. The magnetic field gradient and/or the electromagnetic radiation of the Rubinson reference is generated inside the patient's body. Therefore, as the field gradient of the present invention must be generated outside of the patient's body, the Rubinson reference cannot anticipate the present invention as claimed in claims 28, 31-34, 40, 46-49, 54, 56, 59 and 64 as amended. Reconsideration and withdrawal of the rejection are respectfully requested.

On page 3 of the Office Action the Examiner rejected claims 29, 30, 41-45, 50, 51, 53, 55 and 57-63 under 35 U.S.C. §103(a) as being unpatentable over Rubinson (U.S. Patent No. 5,347,221). The Examiner indicated that Rubinson discloses all of the features of these claims and that it would have been obvious to one of ordinary skill in the art to add the additional features of these claims to the teachings of the Rubinson reference. The Applicant must respectfully disagree.

As discussed above, the Rubinson reference requires that the electromagnetic radiation and the magnetic field gradient are

generated from within the patient's body. In contrast the present invention requires that the magnetic field gradient and the electromagnetic radiation are generated externally from the patient. As independent claims 28, 40, 49, 50, 54 and 57 are believed allowable over the Rubinson reference it is believed that the claims depending either directly or indirectly from these claims are allowable as well. Reconsideration and withdrawal of the rejection are respectfully requested.

With this Amendment new claims 65-69 are added. Independent claim 68 is a combination of original claims 28 and 35. Claim 66 through 69 correspond to dependent claims 36-39. As the Examiner indicated in the Office Action that these claims would be allowable if in written in independent form, the Applicant believes that these claims are allowable. Consideration and allowance of these claims are respectfully requested.

In conclusion, Rubinson neither teaches nor suggests the features of claims 28-69. Reconsideration and allowance of claims 1-69 are respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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NMR/jme

STATUS OF CLAIMS

1. - pending
2. - pending
3. - pending
4. - pending
5. - pending
6. - pending
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69. - pending

SUPPORT FOR AMENDMENTS

Support for amendments made to claims 28, 40, 49, 50, 54, and 57 can be found with reference to FIG. 1

Claim 47 is amended to remove a typographical error that was present in the original version.

Claim 65 is a combination of claim 28, prior to amendment, and claim 35. These claims were supported by the original disclosure.

Claims 66-69 add additional limitations that were presented in claims 36-39, and are supported by the original disclosure